

§102(b)/§103(a) Rejection Over Volke

Claims 13-17, 25-27, 29, 32 and 33 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Volke (USPN 4,743,499).

"A claim is anticipated [under section 102] only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." MPEP 2131 (citing *Verdegall Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

According to MPEP 2142, to establish a case of *prima facie* obviousness, there must be some suggestion or motivation, either in the references or generally known to one of skill in the art, to modify or combine reference teachings, there must be reasonable expectation of success, and the prior art reference must teach or suggest all the claim limitations.

Claim 13 of the present application is requested to be amended as shown above and below. The claim is requested to be amended to include a limitation on the thickness of the foam layer. Support for the limitation on thickness is found in the Examples of the present application, and the high (265 microns) and low (86 microns) numbers can be found specifically in Tables 2 and 6, respectively.

In Volke, the foam may have a thickness of 20 to 80 mils (Volke, col. 3, line 23). Since there are 25 microns per mil, that means that the thickness of the foam in Volke may only be 500 microns to 2000 microns thick.

Since the foams of Volke do not teach the thickness limitation that is present in amended claim 13 of the present application (and dependent claims 14-17), Volke does not render claim 13 anticipated. Volke also does not render the claim obvious because the Volke foams are used in wound dressings and Volke provides no motivation to use a substantially thinner foam layer in the wound dressings.

Furthermore, a dependent claim should be considered allowable when its parent claim is allowed. *In re McCarn*, 101 USPQ 411, 413 (CCPA 1954). Accordingly, Claims 14-17 should be allowed provided Claim 13 is allowed. Therefore, the rejection of claims 13-17 should be withdrawn.

Claims 25 and 29 are also similarly amended (as indicated above) to include the thickness limitation of Claim 13. Therefore, Claims 25 and 29 should be found allowable.

Furthermore, since a dependent claim should be considered allowable when its parent claim is allowed, Claims 26-27 and 32-33 should also be allowed.

In addition, Claim 17 is requested to be amended as set forth above. The amendment has been made for clarification purposes. Support can be found in the Specification on page 8, lines 31-32. Although Claim 17 is novel and non-obviousness based on the argument set forth above, the amendment of Claim 17 serves to address the Examiner's discussion of resiliency in the Office Action.

§102(b)/§103(a) Rejection Over Chen

Claims 13-17 and 25-28 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen (USPN 3,972,328).

In response, Applicants rely upon the same argument that was set forth with regard to the Volke foam. (See section above). Similarly with regard to the Chen foam, the foam is described as being about 20 to about 50 mils thick, which corresponds to 500 to 1250 microns thick (Chen, col. 2, line 26).

Since the foams of Chen do not teach the thickness limitation that is present in amended claim 13 of the present application (and dependent claims 14-17), Chen does not render claim 13 anticipated. Chen also does not render the claim obvious because the Chen foams are used in surgical bandages and Chen provides no motivation to use a substantially thinner foam layer in the surgical bandages.

Furthermore since a dependent claim should be considered allowable when its parent claim is allowed, Claims 14-17 should also be allowed. Therefore, the rejection of claims 13-17 over Chen should be withdrawn.

Claim 25 is also similarly amended (as indicated above) to include the thickness limitation of Claim 13. Therefore, Claim 25 should be found allowable. Furthermore, since a dependent claim should be considered allowable when its parent claim is allowed, Claims 26-28 should also be allowed.

In addition, the amendment of Claim 17 for clarification purposes, as discussed above (in section on Volke), also applies to this rejection.

§102(b)/§103(a) Rejection Over Bello et al.

Claims 13-17, 25-27 and 31 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bello et al. (USPN 5,716,621).

In response, Applicants rely upon the same argument that was set forth with regard to the Volke and Chen foams. (See sections above). Similarly with regard to the Bello foam, the foam is described as being from about 30 to about 120 mils thick, which corresponds to 750 to 3000 microns thick (Bello, col. 3, lines 38-39).

Since the foams of Bello do not teach the thickness limitation that is present in amended Claim 13 of the present application (and dependent claims 14-17), Bello does not render Claim 13 anticipated. Bello also does not render the claim obvious because the Bello foams are used for drug delivery and Bello provides no motivation to use a substantially thinner foam layer as the drug reservoir.

Furthermore, since a dependent claim should be considered allowable when its parent claim is allowed, Claims 14-17 should also be allowed. Therefore, the rejection of Claims 13-17 over Bello should be withdrawn.

Claim 25 is also similarly amended (as indicated above) to include the thickness limitation of Claim 13. Therefore, Claim 25 should be found allowable. Furthermore, since a dependent claim should be considered allowable when its parent claim is allowed, Claims 26, 27 and 31 should also be allowed.

In addition, the amendment of Claim 17 for clarification purposes, as discussed above (in section on Volke), also applies to this rejection.

§102(b)/§103(a) Rejection Over Tenneco

Claims 13, 14 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tenneco Chemicals, Inc. (GB 1321489).

In response, Applicants rely upon the same argument that was set forth with regard to the other references above. (See sections above). Similarly with regard to the Tenneco foam, the foam used in the Examples is 60 mils thick, which corresponds to 1500 microns thick. The foam is subjected to the action of a jet of fluid in order to open cells of the

foam (Tenneco, page 2, lines 20-30), therefore it needs to be thick enough to withstand such pressure.

Since the foams of Tenneco do not teach the thickness limitation that is present in amended Claim 13 of the present application, Tenneco does not render Claim 13 anticipated. Tenneco also does not render the claim obvious because there is no motivation to make thinner foams that might tear upon application of the jet of fluid.

Furthermore, since a dependent claim should be considered allowable when its parent claim is allowed, Claims 14 and 17 should similarly be allowed. Therefore, the rejection of Claims 13, 14 and 17 over Tenneco should be withdrawn.

§103(a) Rejection Over Volke, and Further in View of Chen

Claims 13-17 and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volke (USPN 4,743,499) as applied to Claims 13-17, 25-27, 29, 32 and 33, and further in view of Chen (USPN 3,972,328).

As discussed above, both Volke and Chen are missing at least one element of the claimed invention. When a claimed element is absent from the teachings of a reference, there must be a suggestion to combine the teachings of relied upon reference in order to support an obviousness rejection. A combination of the two references would not include all the elements of the claims of the present application. For example, the thickness limitation added to independent Claims 13, 25 and 29 is not present in the combination of Volke and Chen. Therefore, Claims 13, 25 and 29 should be found allowable. In addition, dependent Claims 14-17, 26-28 and 30-33 should also be found allowable because they depend from allowable Claims 13, 25 and 29.

Support for New Claims

Applicants also request that new Claims 34 and 35, as written above, are allowed in the present case.

Support for Claim 34 appears on page 13 of the Specification, lines 3-14.

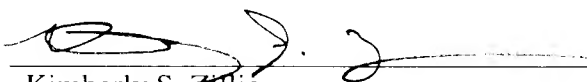
Support for Claim 35 appears on page 12 of the Specification, lines 25-30.

Based on the foregoing, it is submitted that the application is in condition for allowance. Reconsideration of the rejections is requested. Amendment of Claims 13, 17, 25 and 29 is requested. Allowance of Claims 13-17 and 25-33 is also requested. In addition, Claims 34 and 35 are requested to be added and allowed.

The Examiner is invited to contact Applicants' attorney if the Examiner believes any questions or issues could be resolved.

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Version With Markings to Show Changes Made

13. (Twice Amended) An article comprising a breathable foam layer, the layer comprising a thermoplastic, amorphous polymer, the foam layer further having at least one major surface, [and] having porosity in a direction perpendicular to a major surface, and having a thickness of about 86 to about 265 microns.

17. (Amended) The article of claim 13, the moisture vapor transition rate of which can be increased by stretching [the porosity of which may be increased during use by stretching, and which article can recover at least 50% of such increase in porosity upon release from stretching].

25. (Twice Amended) An article comprising at least two layers wherein at least one layer comprises a breathable, amorphous thermoplastic foam having at least one major surface, [and] having at least one ruptured cell, and having a thickness of about 86 to about 265 microns, and wherein the foam layer has porosity in a direction perpendicular to a major surface of the foam, and wherein the second layer comprises a polymeric material.

29. (Twice Amended) An article comprising a breathable three layer ABA structure, wherein the B layer is a breathable thermoplastic foam having at least one major surface, [and] having at least one ruptured cell, and having a thickness of about 86 to about 265 microns, and wherein the B layer has porosity in a direction perpendicular to a major surface of the foam, and wherein the A layers comprise an unfoamed material